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PTO/SB/33 (07-05)
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): YOR920020206US1 (8728-587)

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Application Number	Filed
10/537,571	June 3, 2005

First Named Inventor: Hoi Yeung Chan

Art Unit	Examiner
2129	Brown, Jr., Nathan H.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [XX] attorney or agent of record. Registration number 48,909
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

Nathaniel T. Wallace
Typed or printed name

516-692-8888
Telephone number

Aug 20 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S):	Chan et al.	DOCKET: YOR920020206US1 (8728-587)
SERIAL NO.:	10/537,571	GROUP ART UNIT: 2129
FILED:	June 3, 2005	EXAMINER: Brown Jr., Nathan H.

FOR: **SYSTEM AND METHOD FOR EXTERNALIZED INFERENCING COMPONENTS**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Examiner:

In response to the Final Office Action dated May 23, 2008, Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a **Notice of Appeal** and a **Pre-Appeal Brief Request For Review Form** (PTO/SB/33).

REMARKS

Please consider the following reasons for this Pre-Appeal Brief Request for Review.

Claims 1, 3-10, 13, 16-18, 20 and 36 are pending in the present application. Reconsideration of the rejections in view of the remarks is respectfully requested. Only rejections pertinent to independent claims are addressed herein.

Claims 1, 3-10, 13, 16-18, 20 and 36 stand rejected under 35 U.S.C. §101 for not being directed to a practical application and also for violating the doctrine of preemption.

Claims 1 and 36 are the independent claims.

Claims 1 and 36 claim, *inter alia*, "passing the parameters to an externalized inferencing component upon executing a trigger point in the program of instructions; evaluating, by the externalized inferencing component, the data comprising a set of rules to be interpreted against the parameters to perform an inference external to the program of instructions, wherein the externalized inferencing component is in communication with the program of instructions, wherein the inference is a derivation of the knowledge; storing the knowledge derived by the inference with the data; and outputting the knowledge derived by the inference to trigger point of the program of instructions."

The claimed application of an externalized inferencing component evaluating parameters passed by a trigger point to perform an inference is believed to be a practical application of a method (embodied in a computer readable medium (see Claim 1) and a system for executing a program of instructions in communication with an externalized inference component (see Claim 36)). Consider that in *Diamond v. Diehr*, 450 U.S. 175, 209 USPQ 1 (1981), the Court noted, "when [a claimed invention] is performing a function which the patent laws were designed to protect (e.g., transforming or reducing an article to a different state or thing), then the claim satisfies the requirements of Section 101." *Diehr*, 450 U.S. at 192. In Claims 1 and 36, the claimed computer processes perform inferencing external to a program of instructions and passing parameters by a trigger point for evaluation by an externalized inferencing component to perform the inferencing (external to the program of instruction). The external inferencing results in the derivation of knowledge from the passed parameters, transforming the passed parameters

to a different state and then outputting this derived knowledge to a trigger point of an application. The derivation of knowledge is believed to be a useful, tangible and concrete result of the application of the claimed limitations. Thus, the claimed process is believed to be statutory as being limited to a practical application in the technological arts of computer programming. Therefore, Claims 1 and 36 are believed to be directed towards statutory subject matter.

Turning now to the suggestion that the claims violated the doctrine of preemption: that is whether the claim would, in reality, preempt the use of a law of nature or abstract idea. While one may not patent a process that comprises every substantial practical application of an abstract idea, such as by patenting a mathematical formula, because such a patent in practical effect would be a patent on the abstract idea itself, the claims are clearly presented in terms of a computer readable medium (see Claim 1) and a system for executing a program of instructions in communication with an externalized inference component (see Claim 36). Accordingly, the claims are not directed to mere abstract ideas but include limitations that are both concrete and tangible. Further, consider the method steps of "passing the parameters to an externalized inferencing component" and "evaluating, by the externalized inferencing component, the data comprising a set of rules to be interpreted against the parameters to perform an inference external to the program of instructions, wherein the externalized inferencing component is in communication with the program of instructions, wherein the inference is a derivation of the knowledge" (emphasis added), which comprises substantial limitations outside the realm of mere abstraction without a practical application. While the limitations of the respective independent claims may cover a broad range of computer readable mediums and systems for executing a program of instructions, the claims clearly rise above the level of an abstract idea (typically described as a mere mathematical formula).

For at least the foregoing reasons, there is believed to be clear error in the rejection of Claims 1 and 36. Claims 3-10, 13, 16-18 and 20 depend from Claim 1, and are believed to be allowable for at least the reasons given for Claim 1. Reconsideration of the rejection is respectfully requested.

Claims 1, 3-10, 13, 16-18, 20 and 36 have been rejected under 35 U.S.C. 102(a) as being anticipated by *IBM*, "Websphere Application Server Enterprise Services Business Rule Beans (BRBeans)," 2001 (hereinafter *IBM*). The Examiner stated essentially that *IBM* teaches all of the limitations of Claims 1, 3-10, 13, 16-18, 20 and 36.

Claims 1 and 36 are the independent claims.

Claims 1 and 36 claim, *inter alia*, "passing the parameters to an externalized inferencing component upon executing a trigger point in the program of instructions" and "evaluating, by the externalized inferencing component, the data comprising a set of rules to be interpreted against the parameters to perform an inference external to the program of instructions, wherein the externalized inferencing component is in communication with the program of instructions, wherein the inference is a derivation of the knowledge."

IBM teaches externalized business rules (see page 32). *IBM* does not teach "passing the parameters to an externalized inferencing component upon executing a trigger point in the program of instructions" and "evaluating, by the externalized inferencing component, the data comprising a set of rules to be interpreted against the parameters to perform an inference external to the program of instructions," essentially as claimed in Claims 1 and 36. The externalized business rules of *IBM* adhere to externalization techniques, wherein logic and data are implemented for making classifications, for example, for checking whether a truck weight entered is valid (see *IBM*, page 33, point 1). The externalized business rules of *IBM* are not analogous to externalized inferencing components as claimed in Claims 1 and 36. For example, one could write an externalized business rule as described in *IBM*, however, *IBM* does not teach how to cause the externalized business rule to do inferencing. The externalized business rules of *IBM* are used for making classifications and do not include inference components - for example, the derivation rule (page 3 of *IBM*) simply returns a "value." *IBM* does not teach that the value is new knowledge. The claimed inferencing derives new knowledge from rules and knowledge (data and parameters). *IBM* simply does not teach inferencing; indeed the term "inference" does not appear in the reference. Consider the operation of *IBM's* IF/THEN statement. The IF/THEN statement of *IBM* is a conditional statement used in only classification and lacks inherent inferencing capabilities. The IF/THEN statement, on its own, lacks the complexity for deriving knowledge. The IF/THEN statement is merely a logical argument that cannot be considered an

inference as it, by itself, does not derive knowledge.

For at least the foregoing reasons, there is believed to be clear error in the rejection of Claims 1 and 36. Claims 3-10, 13, 16-18 and 20 depend from Claim 1, and are believed to be allowable for at least the reasons given for Claim 1. Reconsideration of the rejection is respectfully requested.

For the foregoing reasons, the present application, including Claims 1, 3-10, 13, 16-18, 20 and 36, is believed to be in condition for allowance. Early and favorable consideration of the application is respectfully requested.

Respectfully submitted,

Date: August 20, 2008

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